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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/619,549	07/16/2003	Marianne O'Shea	059490-5016	5947

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EXAMINER

WILLIAMS, LEONARD M

ART UNIT	PAPER NUMBER
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1617

DATE MAILED: 02/27/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	Application No. 10/619,549	Applicant(s) O'SHEA ET AL.	
	Examiner Leonard M. Williams	Art Unit 1617	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) ☒ Claim(s) 1-11, 24 and 25 is/are pending in the application.
- 4a) Of the above claim(s) 12-23 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-11, 24 and 25 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |   |   |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                        | 4) <input type="checkbox"/> Interview Summary (PTO-413)                     |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)    | Paper No(s)/Mail Date: ____.  |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date: ____.  | 6) <input type="checkbox"/> Other: ____.                                    |

Detailed Action

***Status of Claims***

The amendment/remarks received in the office 11/22/2005 amending claim 1, canceling claims 12-23 and adding new claims 24-25 have been entered. Claims 1-11 and 24-25 are currently pending.

***Response to Amendment/Arguments***

The applicant's have amended claim 1 to remove reference to the term preventing. This is sufficient to overcome the 112-1 rejection over claim 1 and is thus withdrawn.

The canceling of claims 12-23 renders the 112-1 and 101 rejections of claims 12-23 moot and thus the rejections are withdrawn.

The applicant's state on page 6 of the remarks:

"Cook et al. mention some of the viruses at Column 9, lines 15 to 18 (in particular, coronaviruses, piconaviruses and adenoviruses). However, the disclosure of these viruses does not amount to a disclosure that CLA would be able to treat the symptoms of a common cold. Thus, the disclosure of the viruses themselves is not a disclosure of any illness that they could potentially cause."

The examiner respectfully disagrees. Cook et al. disclose the use of CLA in a method of treating symptoms associated with the production of TNF in animals (including humans) caused by viral infections. Cook et al. does specifically disclose

weight loss as one symptom that can be treated but does not limit the symptoms treatable to only being weight loss. The examiner further points out that the treatment of an animal suffering a viral infection by administration of CLA would inherently treat any and all symptoms associated with infection by the virus. Thus the treatment of symptoms associated with the common cold as currently claimed are inherently treated by the method of Cook et al.

The examiner respectfully points out the following: "Products of identical chemical composition can not have mutually exclusive properties. "A chemical composition and its properties are inseparable. Therefore, if the prior art teaches the identical chemical structure, the properties applicant discloses and/or claims are necessarily present. In re Spada, 911 F.2d 705, 709, 15 USPQ2d 1655, 1658 (Fed. Cir. 1990).

The examiner respectfully points out the following from MPEP § 2112.01: "[T]he discovery of a previously unappreciated property of a prior art composition, or of a scientific explanation for the prior art's functioning, does not render the old composition patentably new to the discoverer." Atlas Powder Co. v. Ireco Inc., 190 F.3d 1342, 1347, 51 USPQ2d 1943, 1947 (Fed. Cir. 1999). Thus the claiming of a new use, new function or unknown property which is inherently present in the prior art does not necessarily make the claim patentable. In re Best, 562 F.2d 1252, 1254, 195 USPQ 430, 433 (CCPA 1977).

For the reasons stated above and further for the reasons of the previous office action the 102(b) rejection is maintained over claims 1-11. New claims 24 and 25 are

also anticipated by the prior art of record under 102(b) as inherent. As the new claims have not been previously addressed, the 102(b) rejection is withdrawn and a new 102(b) rejection is made to address the new claims. The 102(b) rejection is thus expanded to include claims 24 and 25. The expanded rejection is stated below to reflect these changes.

### ***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1-11 and 24-25 are rejected under 35 U.S.C. 102(b) as being anticipated by Cook et al. (US Patent No. 5827885).

Cook et al. teach, in col. 2 lines 30-50, a method of treating symptoms associated with the production of TNF production in animals, including humans, caused by viral infection via administration of a conjugated linoleic acid (CLA).

Cook et al. teach, in col. 8 lines 40-65, that the CLA compositions and their non-toxic derivatives can be added to an animal or human's food or formed into tablets, capsules, solutions, and emulsions. The exact amount to be administered depends on the CLA used but generally will be from about 1ppm to about 10,000ppm in an animal's or human's diet and that the CLA amounts to be added can range from 0.01% to 2.0% or more by weight of the animal's or human's food. As evidenced by the sample menu for

a 2000 calorie food pattern from the USDA's website ([mypyramid.gov/downloads/sample\\_menu.pdf](http://mypyramid.gov/downloads/sample_menu.pdf)) the total amount of food consumed daily (including proteins, carbohydrates, total fats and total dietary fiber) is 460g. If the added CLA is to be 0.01-2% then it would correspond to 0.046-9.2g daily.

Cook et al. teach, in col. 9 lines 4-20, that the method comprising administration of CLA (a conjugated fatty acid) to an animal, including a human, for the treatment of symptoms associated with viral infection includes picornavirus (which includes rhinovirus), togavirus, paramyxovirus, orthomyxovirus, rhabdovirus, reovirus, retrovirus, bunyavirus, coronavirus, arenavirus, parovirus, papovavirus, adenovirus, herpesvirus, and poxvirus anticipating the "...method of...treating a common cold...which comprises administering...conjugated fatty acids and derivatives thereof" of claim 1, the "...method...wherein said mammal is human" of claim 2, the "...method...wherein said mammal is administered a composition comprising a conjugated fatty acid or a derivative thereof and wherein said composition is a pharmaceutical composition, a foodstuff or a food supplement" of claim 3, the "...method wherein the conjugated fatty acid or derivative thereof is conjugated linoleic acid or a derivative thereof" of claim 4, the "...method...for reducing the recovery time after a common cold" of claim 5, the "...method...wherein the common cold is caused by a coronavirus or a rhinovirus" of claim 6, the "...method...wherein the amount of conjugated fatty acid or derivative thereof is from 0.1 to about 20g of conjugated fatty acid or derivative thereof per day" of claim 7, the "...method...wherein the conjugated linoleic acid or derivative thereof comprises trans10, cis12, and cis9, trans11 isomers and the weight ratio of trans10,

cis12 isomer to cis9, trans11 isomer is at least 1.2:1" of claim 8, the "...method...wherein said mammal is administered a composition comprising a conjugated fatty acid or a derivative thereof wherein said composition is a foodstuff..." of claim 9, the "...method...wherein said mammal is administered a composition comprising a conjugated fatty acid or a derivative thereof and wherein said composition is a pharmaceutical composition..." of claim 10, the "...method...wherein said mammal is administered a composition...wherein said composition is a food supplement in the form of a soft gel or hard capsule..." of claim 11, the "...method...which comprises the treatment of one or more of..." of claim 24 and the "...method...for the treatment of sore throat" of claim 25.

The examiner respectfully points out the following: "Products of identical chemical composition can not have mutually exclusive properties. "A chemical composition and its properties are inseparable. Therefore, if the prior art teaches the identical chemical structure, the properties applicant discloses and/or claims are necessarily present. In re Spada, 911 F.2d 705, 709, 15 USPQ2d 1655, 1658 (Fed. Cir. 1990).

The examiner respectfully points out the following from MPEP § 2112.01: "[T]he discovery of a previously unappreciated property of a prior art composition, or of a scientific explanation for the prior art's functioning, does not render the old composition patentably new to the discoverer." Atlas Powder Co. v. Ireco Inc., 190 F.3d 1342, 1347, 51 USPQ2d 1943, 1947 (Fed. Cir. 1999). Thus the claiming of a new use, new function or unknown property which is inherently present in the prior art does not necessarily

make the claim patentable. In re Best, 562 F.2d 1252, 1254, 195 USPQ 430, 433 (CCPA 1977).

### ***Conclusion***

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Leonard M. Williams whose telephone number is 571-272-0685. The examiner can normally be reached on MF 9-5:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Sreeni Padmanabhan can be reached on 571-272-0629. The fax phone




Art Unit: 1617

number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

LMW



STEVEN F. MANAHAN  
SUPERVISORY PATENT EXAMINER